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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,966	11/09/2001	Stephen V. Burakoff	N00389/70006 RJP	3768

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EXAMINER

CHANDLER, SARA M

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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08/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/035,966

Applicant(s)

BURAKOFF ET AL.

Examiner

Sara Chandler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/24/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 114-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/12/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's election without traverse of Invention P (Claims 114-125) in the reply filed on 05/24/07 is acknowledged.

Please note the Examiner for 10/035,966 has changed. The Examiner is now Sara Chandler.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for _____"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the

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intended use or intended result (e.g., "for _____"), but does not result in a structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

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3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 114-125 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,782,506. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to requesting consent from a user for the delivery of information; receiving the consent; and delivering the information to the user.

Claims 114-115 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 7,028,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to requesting consent from a user for the delivery of information; receiving the consent; and delivering the information to the user.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 114-125 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Claimed invention fails to produce a useful, concrete and tangible result.

Claim 114 does not provide "useful" result because applicant has failed to disclose enough information about the invention to make it's usefulness immediately apparent. The MPEP states:

Deficiencies under the "useful invention" requirement of 35 U.S.C. 101 will arise in one of two forms. The first is where it is not apparent why the invention is "useful." This can occur when an applicant fails to identify any specific and substantial utility for the invention or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689 (1966); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 26 USPQ2d 1600 (Fed. Cir. 1993). The second type of deficiency arises in the rare instance where an assertion of specific and substantial utility for the invention made by an applicant is not credible. See also MPEP § 2107.01.

Claim 114 does not provide a "concrete" result. The term "enabling" is abstract because it broadly refers to the concepts of providing the means, opportunity or knowledge to do something. The term "enabling" does not actually require that something is done. In other words, having the means, opportunity or knowledge regarding how to do something does not mean that it will actually be done. Thus, the claim is not concrete because it is both abstract and fails to provide real world value. See also MPEP § 2107.01.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Objections

Claims 118-120 and 123-124 are objected to because of the following informalities:

Re Claims 118 and 120: "once that consent is deemed given by the user" should be -- once the consent is deemed given by the user --.

Re Claims 118 and 120: "enabling the delivery of information" should be -- enabling the delivery of the information --.

Consistent terminology should be used.

Claims 119 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Presently, claim 119 is recited as a system claim that is depending from a method claim.

"The system of claim 118" should be -- The method of claim 118 --.

Claim 124 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Re Claim 124: "The method of any of claims 114-123" should be -- The method of any one of claims 114 --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Re Claims 114 and 115: Claim 115 is indefinite because its meaning is unclear in light of claim 114. That is once the consent is given by the user wouldn't it have to concurrently be received? Wouldn't the consent need to be given by the user and received prior to delivery of the information to the user?

Claim 119 recites the limitation "delivery of information in electronic form". There is insufficient antecedent basis for this limitation in the claim. (I.e., no prior reference has been made to the electronic form).

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 114-122, 124/114-122 and 125/124/114-122 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith, US Pat. No. 6,192,407.

Re Claim: 114: Smith discloses a method comprising:

requesting consent of a user to the electronic delivery of information (Smith, col. 1, lines 40-63; col. 6, line 12-19; col. 7, lines 12-26; col. 11, lines 15-25; col. 15, lines 4-15; col. 15, lines 28-42); and

once that consent is deemed given by the user, enabling the delivery of the information to the user (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 115: Smith discloses the claimed method supra and further discloses receiving the consent (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42).

Re Claim 116: Smith discloses the claimed method supra and further discloses wherein the consent is received over a computer communications link (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line

58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42 In a network environment for the delivery of information, a communication link is inherent).

Re Claim 117: Smith discloses the claimed method supra and further discloses storing the consent (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42).

Re Claim 118: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises sending the information to the user (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 119: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information in electronic form comprises sending the information (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 120: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises providing instructions for obtaining the information electronically (Smith, abstract; col. 1, lines 9-11; col. 2, lines 9-36; col. 3, lines 43+-col. 11, line 24; col. 14, line 11 – col. 15, line 53).

Re Claim 121: Smith discloses the claimed method supra and further discloses wherein enabling the delivery of information comprises providing an address on the World Wide Web where the information is located (Smith, abstract, Fig. 18, col. 2, lines 21-36; col. 14, lines 36-54; col. 15, lines 7+-col. 16, line 44).

Re Claim 122: Smith discloses the claimed method supra and further discloses wherein the consent is deemed given by an affirmative action from the user (Smith, abstract, col. 2, lines 21-36; col. 10, lines 52+-col. 11, line 2; col. 13, lines 19-32; col. 13, line 58+-col. 14, line 4; col. 14, lines 22-30; col. 15, lines 9-42).

124/114-122: Smith discloses the claimed method supra and further discloses wherein the information is sensitive information (Smith, abstract, col. 2, lines 21-36; col. 3, lines 24-36; col. 3, line 58+-col. 4, line 7; col. 11, lines 25-40; col. 12, line 12+ - col. 13, line 32; col. 15, lines 43-53; col. 16, lines 11-20).

125/124/114-122: Smith discloses the claimed method supra and further discloses wherein the information is compliance information (Smith, abstract, col. 2, lines 21-36; col. 3, lines 24-36; col. 3, line 58+-col. 4, line 7; col. 10, lines line 52+-col. 11, line 2; col. 11, lines 25-40; col. 12, line 12+ - col. 13, line 32; col. 15, lines 43-53; col. 16, lines 11-20).

NOTE: The following terms have been given their broadest reasonable interpretation:
sensitive information, compliance information etc.= information.

As discussed supra "sensitive" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

"Sensitive" by definition is something that needs to be handled with tact or caution. In the claimed invention why and how the information is sensitive and how it impacts the claimed invention has not been provided. Furthermore, there are no active steps performed with respect to the sensitive information as compared to any

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information and no unique features or characteristics have been identified as to the sensitive information as compared to any information.

“Compliance” by definition refers to acquiescence to or actions taken in accordance with rule(s) and/or standard(s). In the claimed invention what these rules or standards are have not been provided. Furthermore, there are no active steps performed with respect to the compliance information as compared to any information and no unique features or characteristics have been identified as to any compliance information as compared to the information.

The label of “sensitive information” and “compliance information” is nonfunctional descriptive material.

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106, II.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 123, 124/123, 125/124/123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US Pat. No. 6,192,407.

Re Claim 123: Smith discloses the claimed method supra and further discloses providing user's with access to software to aid in using the delivery services (Smith, Fig. 16, col. 10, lines 36-51; col. 13, lines 58+-col. 14, line 21). Smith fails to explicitly disclose wherein the consent is requested by sending the user a computer-readable device. Official Notice is taken that it was old and well-known at the time the invention was made to place software on computer readable media. For example software is downloaded on various forms of computer readable media for sharing, transport, compatability etc. Thus, to provide wherein the consent is requested by sending the user a computer-readable device was well-known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Smith to provide wherein the consent is requested by sending the user a computer-readable device. One would have been motivated to increase the number of users who are interested in and have access to the delivery services.

Re Claim 124/123: Smith discloses the claimed method supra and further discloses wherein the information is sensitive information (Smith, abstract, col. 2, lines 21-36; col. 3, lines 24-36; col. 3, line 58+-col. 4, line 7; col. 11, lines 25-40; col. 12, line 12+ - col. 13, line 32; col. 15, lines 43-53; col. 16, lines 11-20).

Re Claim 125/124/123: Smith discloses the claimed method supra and further discloses wherein the information is compliance information (Smith, abstract, col. 2, lines 21-36; col. 3, lines 24-36; col. 3, line 58+-col. 4, line 7; col. 10, lines line 52+-col. 11, line 2; col. 11, lines 25-40; col. 12, line 12+ - col. 13, line 32; col. 15, lines 43-53; col. 16, lines 11-20).

NOTE: The following terms have been given their broadest reasonable interpretation:
sensitive information, compliance information etc.= information.

As discussed supra "sensitive" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

"Sensitive" by definition is something that needs to be handled with tact or caution. In the claimed invention why and how the information is sensitive and how it impacts the claimed invention has not been provided. Furthermore, there are no active steps performed with respect to the sensitive information as compared to any information and no unique features or characteristics have been identified as to the sensitive information as compared to any information.

"Compliance" by definition refers to acquiescence to or actions taken in accordance with rule(s) and/or standard(s). In the claimed invention what these rules or standards are have not been provided. Furthermore, there are no active steps performed with respect to the compliance information as compared to any information and no unique features or characteristics have been identified as to any compliance information as compared to the information.

The label of "sensitive information" and "compliance information" is nonfunctional descriptive material.


Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106, II.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 8-20-07
JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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SMC